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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,828	08/06/2003	Tokunori Kato	116781	6764

25944 7590 11/16/2007
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EXAMINER

SMITH, CREIGHTON H

ART UNIT	PAPER NUMBER
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2614

MAIL DATE	DELIVERY MODE
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11/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/634,828

Applicant(s)

KATO, TOKUNORI

Examiner

Creighton H. Smith

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 OCT '07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-13 and 41 is/are pending in the application.
- 4a) Of the above claim(s) 1-4 and 14-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-11 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 41 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5- 8, 10 are rejected under 35 U.S.C. 102(E) as being anticipated by Shnitzer et al, U.S. patent #7,061,901.

Shnitzer et al show in Fig. 5 a device (85) that may comprise the adapter (120 of Fig. 3), col. 8, lines 4-5. Shnitzer et al invention receives communications from a data network (120). A phone call is directed from the data network (120) via device (85) to phone 100, via physical interface 195 and digital phone switch controller (190). Controller (190) receives the incoming signal and transmits a command signal via interface (200) to processor (180), col. 16, lines 15-25. Shnitzer et al adapter, 12-Fig.1; 42-Fig. 2, allows attachment of a standard phone to a computer as a peripheral. The adapter converts a phone's analog signals to a computer's digital signals and vice-versa - Abstract. As shown in Fig. 3, Shnitzer et al adapter is connected between a PC –16 and a phone 10, just like applicant's MFD-2 is connected between telephone 4 and PC 3.

Shnitzer et al disclose in col.15, lines 15-55, what appears to read upon applicant's "audio route switching system." Examiner says "appear" because this phrase is not really written in idiomatic English. What applicant's "audio route switching system" phrase means to the examiner is that by using the 1st command input system (which reads upon a phone's keypad) a

user can switch the audio between the PSTN and Internet (VoIP). In col. 15, Shnitzer et al disclose that if a phone's user decides to accept a call from the PSTN, she will push the "#" button the phone's keypad. This holds the Internet call and switches to the call from the PSTN. Therefore, the 1st command input system of Shnitzer et al is disclosed in col. 15, lines 15-20, where it is disclosed that the "#" is pushed. By pushing the "#" button on the keypad, the audio signal, which is sent through the voice input device, is switched between PSTN ("the telephone line terminal") and the data network/Internet ("the Internet telephone").

Therefore, Shnitzer et al shows a telephone (10, 12, **OR** 16-Fig. 3) that will connect to the PSTN-110 via a telephone line (unnumbered but clearly shown connecting the 2 lower phones 10 through PSTN to PC 16 and on to the Internet). Shnitzer's adapter has an Internet terminal device controlling system – 190 that will inherently control the control signals from the phone 10/40, switch 150 & col. 16, lines 7-12. The first command input system is shown in Fig. 5 as the keypad on phone 100 and disclosed in col. 11, lines 24 et seq. as a dialed number.

Regarding claim 7, applicant's "terminating command" reads upon a button on the phone that will disconnect the call, or simply by the caller placing the handset into the cradle, i.e., on-hook. For claim 8, see col. 2, line 4; col. 16, lines 9-10. For claim 10, see col. 8, lines 33-39.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

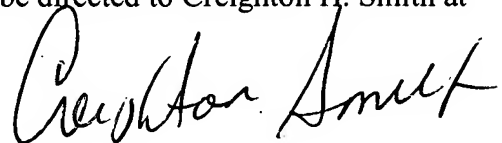
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shnitzer et al in view of Simpson et al, U.S. Publication #2004/0109409.

Simpson discloses in her Abstract an Internet call-waiting message. This call-waiting message reads upon applicant's "interruption message." To have provided Simpson et al disclosure of a call-waiting message into Shnitzer et al telephone device would have been obvious to a person having ordinary skill in the art because references are in the area of telephone devices and provisioning and the skilled practitioner would have readily included Simpson's call-waiting message into Shnitzer et al in order to allow the phone's user to be aware of another, possibly very important, incoming call. Applicant's claim 9 reads upon a voicemail system which is clearly shown by Simpson in Fig. 4.

Claims 12, 13, & 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to Creighton H. Smith at telephone number 571/272-7546.



12 NOV '07

Creighton H Smith
Primary Examiner
Art Unit 2614